REMARKS

1. Claims 1, 2, 4-8, 13-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,789,108 (McMillan) in view of U.S. Patent 6,314,454 (Wang). The Examiner is respectfully requested to withdraw the rejection of these claims in view of the amendments to the claims and in view of the following comments distinguishing the claims over the cited prior art.

Claim 1

In the applicant's method of claim 1, a receiver computer receives a document file residing on a server computer after activating a hyperlink in an email referencing the document. After successfully displaying the image of the document, the receiver computer sends verification data to the server computer indicating that it has successfully displayed the document image.

McMillan teaches a system in which a server computer receives a document file describing a document and then creates and sends an email including embedded software to a receiver computer. The software causes the receiver computer to automatically display the document when the receiver opens the email. Wang teaches an email system in which a receiver computer sends a notification to a server computer when a receiver opens an email. One of skill in the art would be motivated to adapt McMillan's system so that the receiver computer sends the notification to the server computer when the receiver opens the email. Thus the resulting modified version of McMillan's system would be as follows:

a. generating on a sender computer a document file describing a document.

b. sending the document file from the sender computer to the server computer,

c. generating an email at the server computer and sending it to the receiver computer, the email containing software that causes the receiver computer to display an image of the document in a browser window when the email is opened,

d. opening the email at the receiver computer,

e. sending verification data to the server computer indicating that the email was opened, and

f. executing the software at the receiver computer to display the image of the document.

In comparing the method of claim 1 to the combined McMillan/Wang method, we see the following differences.

1. Whereas in step c of claim 1 the email contains a hypertext link referring to a document file on the server, the email of the McMillan/Wang method contains embedded software for generating a document image display.

2. While the applicant's method includes a step d in which the server computer sends a document file to the receiver computer after receiving the hypertext reference to the document file, the McMillan/Wang method includes no such step because the document to be displayed (or rather the software for generating a display of the document) is already embedded in the email.

3. The McMillan/Wang method does not include step e of claim 1, processing a document file sent by a server computer in response to a hypertext reference to the document to produce a display of the document on the receiver computer. The McMillan/Wang method executes software embedded in an email to produce a document display.

4. While the applicant's method (step f) requires the receiver computer to send verification data indicating that the receiver has successfully displayed an image of the document in a browser window, the McMillan/Wang method sends verification data indicating only that the receiver computer has opened the email. Although the software in the McMillan/Wang email is intended to direct the receiver computer to display a document after the email is opened, the notification sent to the server computer does not indicate that the document was successfully displayed; it only indicates that the email was opened. A number of conditions could prevent the receiver computer from successfully displaying the document after the email was opened. For example, the software in the email could be corrupted or inappropriate for execution by the receiver computer, execution of the software could be blocked by antivirus or other software running on the receiver computer, or the receiver could halt execution of the software before it can display the document.

Thus claim 1, as amended, is patentable over the combination of McMillan and Wang. because the combination fails to teach or suggest steps c, d, e and f of claim 1.

Claim 2

McMillan does not teach a receiver returns verification data to the server computer. Wang teaches that a sever stores log data indicating when a receiver computer has opened an email but does not store log data "indicating when the receiver computer returned the verification data to the server computer indicating that the receiver computer has successfully displayed in the browser window the image of the document referenced by the hypertext link" as recited in claim 2. Wang's log data only records the fact that an email was opened.

Claims 4, 14 -17 and 21

Claims 4, 14 - 17 and 21 are patentable over the combination of McMillan and Wang for reasons discussed above in connection with claim 1.

Claim 5

The Examiner indicates that McMillan (col. 7, lines 3-27) teaches to assign a network address to a document file stored on the server, however while this section indicates that a content file (e.g. a document file) is stored on a server, nothing in this section of McMillan says anything about assigning a network address to a document file. The Examiner states that "it is an inherent feature that whenever a file is stored onto a computer, it is assigned a unique file address", however since "file address" is not a term of computer art the Examiner's comment is not entirely clear. A computer that stores files on a hard disk will include a file directory indicating the file name and other information about each file and its position within a hierarchy of folders, and will include a file allocation table indicating where each section of a file is stored on the hard disk. This is the information a computer needs to access a document file. It is not necessary for a computer to assign a "network address" to a file it stores in order to locate it on its root disk. A "network address" is a reference to a file that is assigned to a file residing on a server when the file is to be accessible to other

computers on a network by activating hypertext links to the file. In the applicant's method, the document file is assigned a network address because it has to be identified by the hypertext link in the email (step c, claim 1). In McMillan's system, the document (or software for generating a document display) is embedded in the email. There is no hypertext link to the document and therefore no need for assigning the document residing on the server a network address.

Claims 6 and 7

Step g of claims 6 and 7 requires that the receiver computer provide the server computer with document password associated with the document before receiving the document identified by the hypertext link. Neither McMillan nor Wang teach this.

The Examiner incorrectly cites Kurokawa as teaching assigning a document password to a document. Kurokawa (col. 2, lines 65-67) teaches assigning every user of a document system a user name and a user password that the system uses to identify the user. Kurokawa (col. 2, lines 28-43) also teaches that each document that the system stores has associated with it an "access rights list" that includes the user name of each user authorized to access the document and an indication of the type of access that the user has to that document. When a user wants to access a document, the system requires the user to enter his or her user name and password (col. 2, lines 65-67) and, if the user name is on the list, the user is granted the access to the document of the type indicated on the list (col. 3, lines 3-6).

Thus we see that the "password" of which Kurokawa speaks is a password assigned to the person wishing to access a document uses to identify himself or herself and is not a password that is assigned to a document file as recited in claims 6 and 7. Note that whereas Kurokawa allows a user to access a document after providing the user's own name and password, the applicant's method of claim 7 allows the user (receiver) to access a document only after providing not only a correct user name and password but also the document password assigned to that particular document.

Claim 8

Claim 8 indicates that the document file is derived from a print file generated on the server computer. Neither McMillan nor Wang

teach a method in which a sender computer generates a print file and then processes the print file to generate a document file to be transmitted to a receiver computer via a server computer.

Claim 13

The Examiner relies on McMillan (col. 9, lines 15-52) as teaching that a receiver returns verification data indicating it has successfully displayed a document as an encoded network address. However nothing in the cited section of McMillan suggest anything about such verification data being returned by a receiver or about encoding a network address. Moreover, the Examiner stipulates at paragraph 5 of the office action that McMillan does not teach a receiver computer returns such verification data to a server computer. The Examiner indicates at paragraph 5 that Wang teaches notifying a server when an email has been opened, however nothing in Wang suggests sending verification data to a server in the form of an encoded network address.

2. Claims 9, 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McMillan, Wang and U.S. Patent 6,209,030 (Ohashi). The Examiner is respectfully requested to withdraw the rejection of these claims in view of the amendments to the claims and in view of the following comments distinguishing the claims over the cited prior art.

Claim 9

The Examiner relies on McMillan and Wang as teaching the underlying subject matter of the parent claim 1 of claim 9 and relies on Ohashi as teaching the additional subject matter of claim 9. Claim 9 is patentable over the cited references because, as discussed above in connection with claim 1, McMillan and Wang fail to teach the underlying subject matter of claim 1.
The Examiner cites Ohashi (Abstract) as disclosing a mechanism by which a receiver computer is prevented from performing a print screen operation when displaying an image of document in a browser; however a print screen operation and sending a document file to a printer are two different activities. Preventing a computer from performing a

print screen does not prevent it from sending a print file to a printer.

In a print screen operation, an image of that which is displayed on a screen is printed. Though a receiver computer may display all or a portion of a document described by a document file (such as an html file) on a screen, a print screen command does not send the document file itself to the printer. A print screen command creates a new print file describing only what appears on the screen on a pixel-by-pixel basis and then sends that new print file to the printer. Assume, as contemplated by Ohashi, a browser running on a computer is generating an image of a document such as a web page described by a document file such as an HTML file. A computer generates a display of the browser window and as much of the document as can fit in the window as an array of pixels on a display monitor. In a print screen operation, the computer creates another file that indicates in a language the printer can understand, the position, intensity and color of each pixel, and sends that file to the printer causing the printer to as nearly as possible print an image of what appears on the screen. What is printed will only be a part of a document if not all of the document is currently displayed in the browser window, and will include things other than the document that may also be displayed on the screen, such as the window frame of the browser and any other items that happen to be displayed on the screen. Note that when carrying out a print screen operation while displaying a part or all of a document described by a document file, the computer does not send the document file itself to the printer and does not even consult the document file. It only creates a new file based on the current state of the display and sends that to the printer. Thus preventing a computer from carrying out a print screen operation does not mean that the computer is prevented from forwarding to a printer a document file it has received from a server, when that document file happens to be formatted as a print file.

Document delivery systems normally transmit documents files in a form which cannot be directly understood by a printer such as a word processing, a graphics or HTML file. Software in a receiving computer must first convert the document file into a print file that the printer can understand, and then send the print file to the printer. The printer then prints an image of the entire document and nothing

else. In accordance with the applicant's document delivery method as recited in claims 9, a sender transmits a print file via a server to a receiver, and view software generates a display based on the print file. In accordance with claims 9, the document sender can provide a publication request indicating that the receiver computer is to be prevented from sending that print file to a printer.

Ohashi (abstract) teaches to prevent the computer from carrying out a print screen operation when the computer is displaying an image that includes part or all of a document described by a document file, but nothing in Ohashi teaches to prevent a computer from sending the document file itself to the printer when the document file is in the form of a print file. Ohashi does not contemplate that the document file might itself be a print file that could be sent to a printer. Note also the programming needed to prevent a computer from carrying out a print screen operation is very much different that the programming needed to prevent a computer from forwarding to a printer a particular print file it has received from a server.

Claim 10

Claim 10 is patentable over the combination of McMillan, Wang and Ohashi for reasons cited above in connection with claim 9. Also none of these references teach a method in which a sender computer supplies a compressed print file as a document file to be forward to a receiver computer via a server computer, decompresses the document file at the receiver computer to reproduce the print file, and then generates a display of the document described by the print file as recited in claim 10.

Claim 20

Claim 20 is patentable over the cited references for reasons similar to those discussed above in connection with claim 9.

3. Claims 11, 12, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McMillan, Wang and U.S. Patent 6,237,099 (Kurokawa). The Examiner is respectfully requested to withdraw the rejection of these claims in view of the amendments to the claims and in view of the following comments distinguishing the claims over the cited prior art.

Claims 11 and 12

The Examiner relies on McMillan and Wang as teaching the underlying subject matter of the parent claim 1 of claim 11 and relies on Kurokawa as teaching the additional subject matter of claim 11. Claim 1 is patentable over the cited references because, as discussed above in connection with claim 1, McMillan and Wang fail to teach the underlying subject matter of claim 1.

Claims 11 and 12 are further patentable over McMillan, Wang and Kurokawa for reasons discussed above in connection with claim 6.

Claims 18 and 19

Claims 18 and 19 are patentable over the combination of McMillan, Wang and Kurokawa for reasons discussed above in connection with claims 11 and 12.

4. Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of McMillan, Wang and U.S. Patent 6,243,722 (Day). The Examiner is respectfully requested to withdraw the rejection of these claims in view of the amendments to the claims and in view of the following comments distinguishing the claims over the cited prior art.

Claim 3

The Examiner relies on McMillan and Wang as teaching the underlying subject matter of the parent claim 1 of claim 3 and relies on Day as teaching the additional subject matter of claim 3. Claim 3 is patentable over the cited references because, as discussed above in connection with claim 1, McMillan and Wang fail to teach the underlying subject matter of claim 1.

Claim 22

The Examiner relies on McMillan and Wang as teaching the underlying subject matter of the parent claim 14 of claim 22 and relies on Day as teaching the additional subject matter of claim 22. Claim 22 is patentable over the cited references because McMillan and Wang fail to teach the underlying subject matter of claim 14 for the reasons discussed above in connection with claim 1.

5. In view of the foregoing amendments and remarks it is believed the application is in condition for allowance. Notice of Allowance is therefore respectfully requested.

Respectfully submitted,

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